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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER	
NOVOSAD, J	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

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1-File Copy

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Applicants' letter regarding the advisory action and interview summary filed on April 19, 2001 is acknowledged. With respect to this letter, several inaccuracies and allegations have been set forth which require a response on the part of the examiner to set the record straight.

At the outset, it is acknowledged that a telephonic interview was held on March 5, 2001. Note the PTO-413 Interview Summary form included as a part of Paper No. 9. With respect to applicants' comments about when this interview summary form was received, applicants' attention is directed to MPEP 713.04 wherein it is explicitly stated that in the case of a telephonic interview the interview summary copy is mailed to applicants either ***with*** or prior to the next official communication. In as much as the Advisory Action of Paper No. 9 was the "next official communication", the examiner's interview summary for the March 5, 2001 telephonic interview was timely provided to applicants in accordance with established Office procedures.

Further, review of applicants' amendment filed after final on March 12, 2001 reveals that applicants failed to include the substance of the March 5, 2001 interview (or any acknowledgment of such interview) as a part of the formal written reply to the Final Office action as is required by MPEP 713.04.

With respect to the content of the interview, itself, applicants' statements that there was agreement that the proposed changes put all claims but possibly claim 6 in condition for allowance is incorrect. In particular, it was stated by the examiner that the proposed changes would overcome the rejection of record. There was no indication or agreement on the part of the examiner that the application would then be in condition for allowance. Further, the examiner

never expressed that the amendment did not raise new issues and would otherwise be entered at least for purposes of appeal. While it is unfortunate and regrettable that applicants concluded that overcoming the rejection of record equated to the application now being in condition for allowance and thus would be entered, the fact still remains that the examiner did not agree that the proposed amendment would prima facie place the application in condition for allowance and applicants' presumption of such was premature.

With respect to applicants' proposed amendment filed on March 12, 2001, it should first be noted that applicants cannot, as a matter of right, amend any finally rejected claims. See 37 CFR 1.116.

Second, limitations not previously present were being newly proposed and presented. These new limitations clearly raised new issues that the examiner would have to consider. The examiner spent considerable extra effort in considering applicants' proposed amendment to fully determine whether or not the proposed changes would place the claims in condition for allowance. This was performed as a matter of courtesy to applicants in an effort to expedite placing the application in condition for allowance, not because the supervisory patent examiner "had become uncomfortable with the scope of the claims". When it was determined that the proposed response would not prima facie place the claims in condition for allowance, applicants' representative was contacted to suggest a possible examiner's amendment to place the claims in condition for allowance. The examiner's efforts to work out an examiner's amendment were refused.

In view of the fact that no agreement could be reached for an examiner's amendment, the examiner issued an Advisory Action. Further, since the proposed amendment after Final Rejection did not place the application in prima facie condition for allowance or otherwise simplify the issues on appeal, but rather raised new issues requiring further consideration and/or search, the proposed amendment was not entered. See MPEP 714.13.

The principles and procedures of examination after Final Rejection are well-established and presumed to be understood. Applicants' representative professes to be "at a loss" at how the amendment raises new issues and does not place the application in better form for appeal. However, it is also noted that applicants' representative fails to point out where these newly proposed limitations were present in the finally rejected claims or how the issues would be reduced. Further, it is not explained or otherwise shown why these changes are necessary and were not earlier presented. See 37 CFR 1.116. Nevertheless, it is evident that limitations not previously presented ***before*** Final Rejection for the examiner's consideration are "new" limitations when presented ***after*** Final Rejection. Further, if these limitations were not considered by the examiner previously (because they were not present to be considered in the first place), it naturally follows that their consideration after Final ***raises*** a new issue. Further still, if issues/limitations are being ***added*** for the examiner to consider, then issues are not being reduced for appeal. Finally, it is evident that new issues are raised when an amendment is proposed that would overcome the rejection of record but would not otherwise place the claims in condition for allowance because another rejection based on other prior art references would have to be applied.

With respect to applicants' concluding remarks, it should be noted that after final practice does not sanction reopening of prosecution merely because an applicant has filed an amendment under 37 CFR 1.116 that would overcome the current rejection of record but not otherwise place the application in condition for allowance. Rather, the fact that another art rejection is applicable and would have to be applied is clear evidence of the new issue being raised that warrants the proposed amendment being denied entry. Since neither the statutes nor the Rules of Practice confer any right on an applicant to an extended prosecution and the application was properly made Final, it is strongly suggested that applicants' file a continuing application if it is their desire to continue with prosecution. If applicants' believe that the claims, as finally rejected, are properly patentable, then a Notice of Appeal should be filed.

In summary, the prosecution of the instant application will not be reopened as a result of applicants' mistaken understanding that resulted from the interview of March 5, 2001 as the record is clear and explicit that no agreement was reached that the proposed changes placed the application in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is (703) 305-2872. The examiner can normally be reached on Monday through Thursday from 7:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Daniel P Stodola

Jennifer E. Novosad/ds
April 1, 2001

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